

AMENDMENT TO THE DRAWINGS

The attached Replacement Sheet of drawings includes changes to FIG. 2. This Replacement Sheet, which includes FIG. 2, replaces the original sheet including FIG. 2.

Attachment: Replacement Sheet (1)

REMARKS

Claims 31 through 54 and 61 through 77 are pending in this Application. FIG. 2 has been amended. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, FIG. 3, ¶¶ [0023] through [0026] of the corresponding US Pub. No. 2005/0239405. Applicants submit that the present Amendment does not generate any new matter issue.

Claims 31, 32, 51, 52, and 62 through 64 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

In stating the rejection, the Examiner asserted that the recitations of “a computer program” and “a computer readable medium” in claim 64 are not disclosed in the specification. This rejection is traversed.

The recitation of “a computer program” is fully supported by at least “programs” described in ¶ [0037] of the corresponding publication, and the recitation of “a computer readable medium” is fully supported by at least “memory 6-18” shown in FIG. 6 and described in ¶ [0038] of the corresponding publication, thereby overcoming the states basis for the rejection.

The Examiner further asserted that the recitation of “establishing the group communication in the second communication network” in claims 31, 32, 51, 52 and 62 through 64 is not disclosed in the specification. This rejection is traversed.

Literal support is not required by the statute. *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 923 (Fed.Cir.2004); *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1566-67 (Fed.Cir.1997). An applicant need not utilize any particular form of disclosure to

describe the subject matter claimed; the description need only allow persons of ordinary skill in the art to recognize that he or she invented what is claimed. *Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.*, 541 F.3d 1115, 1122 (Fed.Cir.2008) (quoting *In re Alton*, 76 F.3d 1168, 1172 (Fed.Cir.1996)).

In applying the above legal tenets to the exigencies of this case, Applicants submit that the imposed rejection is not factually accurate. Specifically, the recitation “establishing the group communication in the second communication network” is fully supported by at least the originally filed claims 1 through 30, and the following paragraphs of the corresponding published application. It should be noted that the first communications network N1 refers to a short-range communications medium, and the second communication network N2 refers to a mobile communication network. The group information (i.e., the list of people/equipments) is exchanged over the first communications network N1 with short-range capabilities, while the group communication is established/carried out over the second/mobile communications network N2.

Abstract:

The invention relates to a method of **establishing a communications group in a communication network** wherein a request from master user equipment (UEA) is sent (2-4, 2-5) to at least one slave user equipment (UEB, UEC) via a **short-range communications medium**, said request prompting the user of the slave user equipment (UEB, UEC) to send user information for group establishment. The slave user equipment (UEB, UEC) sends a response (2-8, 2-12) comprising user information for group establishment over the short-range communications medium to the master user equipment (UEA). The master user equipment (UEA) creates the group based on the information received in responses from the at least one slave user equipment (UEB, UEC) and sends the information on the created group to the actual mobile communications network for establishing said group. When the group has been created, the user equipment can **initiate group communication in the mobile communication network**. (Emphasis added).

[0008] The invention is based on the idea of **establishing a communications group in a communications network** by sending from master user equipment to at least one slave user equipment via a **communications medium, preferably a short-range communications medium that is separate from the primary communications medium of the communications network**, a request prompting the user of the slave user equipment to send user information for group establishment in the communications network. (Emphasis added).

[0023] After UEA, the creator of the group, has entered the network **N1**, e.g. a room in an office building, he has to find out who is present and what are the identifications of the present user equipment. FIG. 2 describes these functions for establishing the group by means of a signaling chart. In step 2-2 the user UEA comes to a geographical or a coverage area where a group of equipment is located nearby. If user UEA has decided to establish the group, it can send a multicast request. The request can be sent in broadcast, in which the invitation, i.e. the request is directed to all mobile station-which are located in the same area. In step 2-4 the request is sent to the user UEB using a multicast address. (Emphasis added).

[0024] The user equipments UEB and UEC, which are conventionally connected to a second communication network **N2**, such as a GSM network, are prepared to receive the multicast request within the same first network **N1**, such as a wireless local area network or a Bluetooth network, handle the request corresponding in steps 2-6 and 2-10. The requested information can comprise information needed to **establish the group** as described in FIG. 1 plus some other additional information, such as priorities. After that UEB and UEC send their responses correspondingly to the group creator UEA in steps 2-8 and 2-12. (Emphasis added).

[0031] In step 5-10 it is checked whether the data should be stored in the infrastructure. If data is to be stored in the infrastructure, e.g. in a network other than WLAN network, **the information on the created group is sent to the infra (step 5-12), e.g. to the second network for establishing said group**. If the data is not stored in the infrastructure, the process proceeds directly to the step 5-14. (Emphasis added).

Based upon the foregoing, Applicants submit that the imposed rejection of claims 31, 32, 51, 52, and 62 through 64 under the first paragraph of 35 U.S.C. § 112 for lack of adequate descriptive support is not factually viable and, hence, solicit withdrawal thereof.

Objection to the Drawings.

The Examiner objected to the drawings, asserting that FIG. 2 references the wrong numbers N1, N2 in contrast to the ones in FIG. 3. In response, FIG. 2 has been amended to be consistent with FIG. 3 and ¶¶ [0023] through [0026] of the corresponding published application, thereby overcoming the states bases for the drawing objection. Accordingly, withdrawal of the objection to the drawings is solicited.

Claims 31 through 43, 45 through 54, 61 through 73, 76, and 77 were rejected under 35 U.S.C. § 102(e) and being anticipated by *Kotzin* (US 7,002,942).

In stating the rejection, the Examiner asserted that *Kotzin* discloses all elements of the claimed inventions. Applicants respectfully traverse this rejection.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, as those elements are set forth in the claims, such that the claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1308, (Fed. Cir. 2008); *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367 (Fed. Cir. 2002); *Candt Tech Ltd. v. Resco Metal & Plastics Corp.*, 264 F.3d 1344 (Fed. Cir. 2001). Moreover, when imposing a rejection under 35 U.S.C. § 102 for lack of novelty, the Examiner is required to specifically

identify where in the applied reference disclosed each and every feature of the claimed invention, particularly when such is not apparent as in the present case. *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452 (Fed. Cir. 1984). That burden has not been discharged. Indeed, there are fundamental differences between the claimed inventions and *Kotzin* that scotch the factual determination that *Kotzin* discloses, or even remotely suggests, any of the claimed inventions.

Specifically, independent claims 31, 32, 51, 52, and 62 through 64 recite “establishing the group communication in the second communication network” that undermine the prior art rejection. This feature is not disclosed or suggested by *Kotzin*. That difference alone is sufficient to destroy the rejection for lack of novelty under 35 U.S.C. § 102.

In the ultimate paragraph on page 2 of the Office Action, the Examiner responded to previously advanced arguments by asserting that “it makes no sense to request peers for a group establishment in the first communication network and yet the group is established in the second communication network instead”. The relevance of that assertion anent the factual determination of novelty under 35 U.S.C. § 102 is not apparent. At any rate, to clarify the record, the claimed inventions use the first network to exchange group member information to avoid *manually* entering by a master user the list of people/equipments of a new group into a user terminal (§ 0004)]. By requesting group participant ID information to be *electronically* set up by a master user equipment via the first communications medium/network N1, the claimed inventions avoid inconvenience and burden caused by the conventional approach of *manually* entering the list of people/equipments. The claimed inventions exchange the group information (i.e., the list of people/equipments) over the first/short-range communications medium/network N1 (e.g., in a room of a building), then establish/carry out the group communication over the

second/mobile communications network N2. Thus the claimed inventions do make sense and provide advantages not disclosed, suggested, or contemplated by the applied prior art.

It would appear from page 3 of the Office Action, lines 1 through 3, that the Examiner correctly understood that the first communications medium/network N1 refers to a short-range communications medium, and the second communication network N2 refers to a long-range or wide area communication network. However, the Examiner may not have understood the meaning of “establishing group communication” and the meaning of “group establishment.”

In the context of the present disclosure, there are significant differences between “group establishment” and “establishing group communication.” As described in the application, during the “group establishment,” group information (i.e., group member list and IDs) is collected via the first network. The group members then start communicating data other than the group member information (e.g., advertisement, ¶ [0045]) via the second network (i.e., “establishing group communication”). The claimed inventions only collect group member information via the first network, but do not communicate data other than the group member information (e.g., advertisement) via the first network. The subsequent commutation of data other than the group member information is carried out via the second communication network.

In contrast, *Kotzin* merely establishes a group of close by subscribers 106a-106n to exchange resources capability information (e.g., bandwidth) via the first/short-range network, “*to allow communication with the wireless wide area network*” (FIG. 1; col. 6, lines 19-35). The communication is to facilitate one of the subscribers to communicate with the network 104, rather than any group communication among the subscribers. For example, if a wireless unit 106d wishes to send large amounts of data and also make a telephone call, while not having sufficient bandwidth to perform both operations, the unit 106d sends at least a part of the

data/voice to the wide area network 104 via another wireless unit 106a (“*communicated to the wide area network 104 via the wireless unit 106a on behalf of the wireless unit 106d*”).

The group of independent wireless apparatus 106a-106n in *Kotzin* are identified and coordinated using the short-range communication system 102 (col. 8, lines 9-11), and they communicate with the network element 400 via a WAN (col. 9, line 66 to col. 10, line 27). For example, each of the proximal wireless units 106b-106n communicates with the wide area network 400 by messages 512a-512d (FIG. 5), contributes its portion of bandwidth to the communication destined for the wireless apparatus 106a, and re-transmits the respective portion of the communication to the wireless apparatus 106a as shown by messages 514a-514d. Indeed, the wireless apparatus 106a-106n communicate with each other via the short-range communication system 102 while having communication with the second (cellular) network as asserted by the Examiner on page 3, lines 10-12 of the outstanding Office Action. However, the wireless apparatus 106a-106n, at best, communicates with each other via the short-range communication system 102, but not via the WAN. *Kotzin* is silent about “establishing the group communication in the second/mobile communication network” as recited in the independent claims

The above-argued fundamental and functionally significant differences between the claimed inventions and *Kotzin* undermine the factual determination that *Kotzin* *identically* discloses the same inventions as required under 35 U.S.C. §102(a). *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 31 through 43, 45 through 54, 61 through 73, 76 and

77 under 35 U.S.C. § 102(c) for lack of novelty based on *Kotzin*. is not factually viable, and hence, solicit withdrawal thereof.

Claim 44 were rejected under 35 U.S.C. § 103 for obviousness predicated upon *Kotzin*. in view of *Jamieson et al.* (US 2002/0034959).

This rejection is traversed. Specifically, claim 44 depends from independent claim 31. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 31 under 35 U.S.C. § 102 for lack of novelty as evidenced by *Kotzin*. The secondary reference to *Jamieson et al.* does not cure the previously argued deficiencies of *Kotzin*. Accordingly, even if the applied references are combined as proposed by the Examiner, and Applicants do not agree that the requisite basis to support the asserted motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir.1988). Applicants, therefore, submit that the imposed rejection of claim 44 under 35 U.S.C. § 103 for obviousness predicated upon *Kotzin* in view of *Jamieson et al* is not factually or legally viable and, hence, solicit withdrawal thereof.

Claims 74 and 75 were rejected upon *Kotzin* in view of *Randall et al.* (US 7,248,677).

This rejection is traversed. Specifically, claim 74 depends from independent claim 31 and claim 75 depends from independent claim 62, Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 31 and 62 under 35 U.S.C. § 102 for lack of novelty as evidenced by *Kotzin*. The secondary reference to *Randall et al.* does not cure the previously argued deficiencies of *Kotzin*. Accordingly, even if the applied references are combined as proposed by the Examiner, and again Applicants do not agree that the requisite

basis to support the asserted motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, *supra*. Applicants, therefore, submit that the imposed rejection of claim 74 and 75 under 35 U.S.C. § 103 for obviousness predicated upon Kotzin in view of *Randall et al* is not factually or legally viable and, hence, solicit withdrawal thereof.

Based upon the foregoing, it is apparent that the imposed objection and rejections have been overcome, and that all pending claims are in condition for immediate allowance. Favorable consideration therefore is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at 703-519-9954 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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